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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,480	10/05/2000	Yasuo Suzuki	197484US0	7558

22850 7590 04/18/2002

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1753

12

DATE MAILED: 04/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



7C-12
UNITED STATES DEPARTMENT OF COMMERCE
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EXAMINER

ART UNIT

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DATE MAILED: 12

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
(b) ☐ they raise the issue of new matter. (see NOTE below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

4. ☒ Applicant's reply has overcome the following rejection(s):
see attachment, paragraph 1
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment, paragraph 2
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1, 3-7, 10, 11, 13-17, 20, 22-26, 29, 31-35
Claim(s) withdrawn from consideration: _____
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☒ Other: Interview Summary of 2/6/02, attachment

JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700



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EXAMINER INTERVIEW SUMMARY RECORD

All participants (applicant, applicant's representative, PTO personnel):

(1) Mr. John Pike (Reg. No. 41,253) (3)

(2) Janis L. Dote (4)

Date of interview: Feb. 6, 2002

Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☒ No. If yes, brief description:

Agreement ☐ was reached with respect to some or all of the claims in question. ☐ was not reached.

Claims discussed: all pending

Identification of prior art discussed: JP'711 and Suzuki

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Applicants' representative requested an interview after Final rejection to discuss the showing in the specification. The examiner replied that she would not grant an interview. The showing in the specification was considered in the Final rejection. The specification reports different results for similar compositions tested under similar conditions disclosed in Suzuki. The examiner stated that Applicants should explain why the results in the specification differ from those in Suzuki.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

- ☒ 1. It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph below has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (e.g., items 1-7 of the second page of this form). If a response to the last Office action has already been filed, then applicant is given one month from this interview date to provide a statement of the substance of the interview.

- ☐ 2. Since the examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the substance of the interview unless box 1 above is also checked.

Janis L. Dote

1. The terminal disclaimer filed on Apr. 8, 2002, in Paper No. 11, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,136,483 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Accordingly, the obviousness-type double patenting rejections of claims over U.S. Patent No. 6,136,483 (Suzuki) in view of the other cited references, set forth in the Final rejection in Paper No. 9, paragraphs 9-11, are withdrawn.

2. For the reasons set forth in the Final rejection, Paper No. 9, the rejections over the combined teachings of JP'711 and JP'250 stand. As discussed in Paper No. 9, paragraph 12, item (1), the reasons to combine the references do not have to be applicants' reasons. (The examiner did not state that the benefit sought by applicant, the reduction in the occurrence of black spots, was expected from the teachings in JP'250, as alleged by applicants in their response filed after Final rejection in Paper No. 10.) As discussed in the Final rejection and noted by applicants in No. 10, page 2, lines 15-20, JP'250 provides ample reasons to use its sulfur-containing antioxidant in the charge transport layer of JP'711's photoconductor. Furthermore, for the reasons discussed in Paper No. 9, paragraph 12, item (3), applicants's showing in the specification is insufficient to

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overcome the rejection. As stated in Paper No. 9, "[o]n the present record, it appears that the use of the particular sulfur-containing compounds recited in the instant claims does not provide unexpected results in image quality as alleged by applicants."